

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Sek Chung Fung <i>et al.</i>	Confirmation No.:	4825
Application No.:	10/583,927	Art Unit:	1643
Patent No.:	8,067,199		
Int'l Filing Date:	December 23, 2004	Examiner:	Rawlings, Stephen L.
For:	NOVEL ANTI-IL 13 ANTIBODIES AND USES THEREOF	Attorney Docket No.:	12279-187-999

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The above-identified patent application, U.S. patent application no. 10/583,927 (hereinafter "the '927 application"), which was a national stage of PCT International Patent Application No. PCT/US2004/043501, issued as U.S. Patent No. 8,067,199 (hereinafter "the '199 patent") on November 29, 2011. Patentee hereby respectfully requests reconsideration of the patent term adjustment indicated on the '199 patent. The '199 patent indicates patent term adjustment under 35 U.S.C. § 154(b) of 880 days. However, Patentee believes that the patent term adjustment should be 889 days.

A request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) must be filed within two months of the date the patent issued and must comply with the requirements of 37 C.F.R. § 1.705(b), which are detailed below:

- (1) the fee set forth in 37 C.F.R. § 1.18(e); and
- (2) a statement of the facts involved, specifying:
 - (i) the correct patent term adjustment and the basis or bases under 37 C.F.R. § 1.702 for the adjustment;

- (ii) the relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) to which the patent is entitled;
- (iii) whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and
- (iv)(A) any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704; or
- (B) that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

See 37 C.F.R. § 1.705(b).

The present Request is filed within two months of the date the above-identified Patent issued, *i.e.*, by January 29, 2012, and thus is timely under 37 C.F.R. § 1.705(d).

The present Request raises an issue that could *not* have been raised under 37 C.F.R. § 1.705(b), because the issue relates to dates subsequent to the date the Notice of Allowance was mailed.

In support of this Request, Patentee submits the following:

1. Fee Required Under 37 C.F.R. § 1.705(b)(1)

Pursuant to 37 C.F.R. §§ 1.705(b)(1) and 1.18(e), it is estimated that the required fee for filing this Request is \$200.00. The Director is hereby authorized to charge the required fee(s) to Jones Day Deposit Account No. 50-3013. In the event any additional fees are required, please charge them to Jones Day Deposit Account No. 50-3013.

2. Statement Required Under 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.705(b)(2), Patentee submits the following statement of facts in support of this Request:

- (i) The correct patent term adjustment is 889 days, and the bases for this patent term adjustment are attributable to:
- (a) “**A period delay**”: the failure of the United States Patent and Trademark Office (“USPTO”) to mail a notification under 35 U.S.C. § 132 not later than fourteen months after the date on which the ‘927 application fulfilled the requirements of 35 U.S.C. § 371 in an international application (delay of 198 days under 37 C.F.R. § 1.702(a)(1));
 - (b) “**B period delay**”: the failure of the USPTO to issue a patent within three years after the date on which the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application (delay of 889 days under 37 C.F.R. § 1.702(b));
 - (c) reduction of 198 days of overlap between the A period delay and the B period delay occurring from March 29, 2010 to October 13, 2010; and
 - (d) reduction of period of adjustment of patent term under 37 C.F.R. § 1.704 of 0 days.
- (ii) The relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) are as follows:
1. Adjustment under 37 C.F.R. §§ 1.703(a) through (e):
 37 C.F.R. § 1.703(a):

An adjustment is sought under 37 C.F.R. § 1.703(a)(1), which provides, in relevant part, that the period of adjustment is “[t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.”

The patent term adjustment calculated by the USPTO correctly included the time period under 37 C.F.R. § 1.703(a)(1) for the period beginning March 29,

2010 (fourteen months after the date on which the '927 application fulfilled the requirements of 35 U.S.C. § 371, *i.e.*, January 29, 2009), and ending October 13, 2010, the date an Office Action was mailed from the USPTO. This period consists of 198 days.

37 C.F.R. § 1.703(b):

An adjustment is sought under 37 C.F.R. § 1.703(b), which provides, in relevant part, that “the period of adjustment under 37 C.F.R. § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.”

The patent term adjustment calculated by the USPTO correctly indicates that this period consists of 889 days, which is the period from June 23, 2009 (three years after June 23, 2006, *i.e.*, the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application) to November 29, 2011 (the date the '199 patent issued).

37 C.F.R. § 1.703(c)-(e):

There is no patent term adjustment under these subsections.

2. Adjustment under 37 C.F.R. § 1.703(f):

According to 37 C.F.R. § 1.703(f): “The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not *overlapping*, less the sum of the period calculated under § 1.704.” (emphasis added). *See* 37 C.F.R. § 1.703(f).

The total USPTO delay under 37 C.F.R. § 1.703(a)-(e) for the adjustment should be a summation of the delays under 37 C.F.R. § 1.703(a) and 37 C.F.R. § 1.703(b) minus the overlapping days between the period of such delays, or at least 889 days (the sum of 198 days and 889 days minus 198 days).

The number of days overlapping between the delay under 37 C.F.R. § 1.703(a) and the delay under 37 C.F.R. § 1.703(b) is 198 days. The overlapping days are attributed to the calendar days of the delay under 37 C.F.R. § 1.703(a)(1), beginning March 29, 2010 and ending October 13, 2010, which overlap with the calendar days of the delay under 37 C.F.R. § 1.703(b), beginning June 23, 2009 and ending November 29, 2011.

As discussed in section (iv) below, Patentee believes that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

Accordingly, Patentee believes that the total period of adjustment due under 37 C.F.R. § 1.703(f) is ~~889~~ days, which is the sum of the periods calculated by the USPTO under 37 C.F.R. §§ 1.703(a) through (e) (*i.e.*, 889 days), to the extent that such periods are not overlapping, less the sum of the periods calculated under Section 1.704 (*i.e.*, 0 days).

- (iii) The '199 patent is not subject to a terminal disclaimer.
- (iv) There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704, contrary to the USPTO's determination of 9 days of Applicants' delays.

The USPTO determined that there were no delays by Applicants except for an alleged delay by Applicants of 9 days for the Supplemental Information Disclosure Statement Under 37 C.F.R. §§ 1.56 and 1.97 ("SIDS") filed October 10, 2011. *See* USPTO's Patent Application Information Retrieval page for U.S. Application No. 10/583,927, at "Patent Term Adjustments" Tab, as retrieved on January 22, 2012 (a copy of which is enclosed herewith as Exhibit A). This SIDS was filed after a Notice of Allowance issued on July 18, 2011. Patentee submits that the filing of this SIDS does not constitute a failure to engage in reasonable

efforts to conclude processing or examination of the '927 application under 37 C.F.R. § 1.704(c)(10) for the reasons set forth below.

According to 37 C.F.R. § 1.704(c)(10), “[s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of: (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (ii) Four months.”

Moreover, 37 C.F.R. § 1.704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Accordingly, Patentee submits that the SIDS filed on October 10, 2011 is not considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application, *e.g.*, under 37 C.F.R. § 1.704(c)(10), because the SIDS was accompanied by the statement specified under 37 C.F.R. § 1.704(d). A copy of the SIDS filed on October 10, 2011 is enclosed herewith as Exhibit B. Therefore, Patentee submits that there are no delays by Applicants for the SIDS filed October 10, 2011.

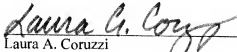
In summary, the total delays by the USPTO under 37 C.F.R. § 1.702 is 889 days, the total delays attributable to Applicants under 37 C.F.R. § 1.704 is 0 days, and thus, the total period of

adjustment due under 37 C.F.R. § 1.703(f) is believed to be 889 days. Accordingly, Patentee respectfully requests an adjustment of patent term totaling 889 days.

Patentee respectfully requests grant, and entry into the file, of this Request. The USPTO is invited to contact the undersigned regarding any questions concerning any of the above.

Respectfully submitted,

Date: January 27, 2012



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